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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/877,036	06/11/2001	William V. Goodhue	5411	9802

7590 06/13/2003
Breiner & Breiner, L.L.C.
P.O. Box 19290
Alexandria, VA 22320-0290

EXAMINER

SMITH, JAMES G

ART UNIT	PAPER NUMBER
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3723

DATE MAILED: 06/13/2003

14

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/877,036

Applicant(s)

GOODHUE ET AL.

Examiner

James G. Smith

Art Unit

3723

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 May 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-14, 16-31, 68-93 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 2-14, 16-31 and 69-93 are finally rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1, from which the above claims depend, recites that the cartridge holder is “constructed to receive **a cartridge**” (emphasis added), thus claim 1 lists the specific function of the cartridge holder as receiving **a cartridge**. Claims 2, 16 and 23 recite “a cartridge” again thus these claims imply that there is **another cartridge that is received in the holder**. This is clearly contrary to the specification, thus rendering claims 2-13 and 16-31 indefinite.

Also, claims 1 and 69 are to a screw gun “for driving a fastening means” and applicants argue that the fastening means is not part of the invention. Claims 10, 11, 13, 26, 29-31, 77, 78, 91 and 92 recite only structure of the fastening means, thus it is confusing as to how the screw gun of claims 1 and 69 can be used to drive a fastening means and also include a fastening means at the same time as required by these claims. Also, other claims, e.g. claims 26 and 89, recite “a fastener”, which appears to be different than the “fastening means” already recited.

3. Normally a claim which fails to comply with the first and/or second paragraph of § 112 will not be analyzed as to whether it is patentable over the prior art since to do so would of necessity require speculation with regard to the metes and bounds of the claimed subject matter, **In re Steele**, 308 F.2d 859, 862-63, 134 USPQ 292, (CCPA 1962) and **In re Wilson**, 424 F.2d 1382, 1385, 496 USPQ 494, 496 (CCPA 1970).

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 1 and 68 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by any of Potucek et. al. or Manino as all that is claimed is a drive unit and guide post that slidably mounts a cartridge holder and has a camming means to move the holder.

Response to Arguments

6. Applicant's arguments filed 15 May 2003 have been fully considered but they are not persuasive.

The amendment to claim 1 only reinforces that fact that the cartridge is part of the gun as its function within the structure of the gun is clearly being claimed. To therefore recite in various dependent claims "a cartridge" only renders the claims unsupported by the original specification and drawings.

With respect to the "fastening means", the amendment in no way changes the ambiguity of the claims.

Claims 1 and 68, the only definite and clearly supported claims, recite only a screw gun that has a holder with a cartridge and the holder is movably supported on the guide of the gun and feeds the cartridges to the bit. This is clearly shown in the two cited patents.

Conclusion

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

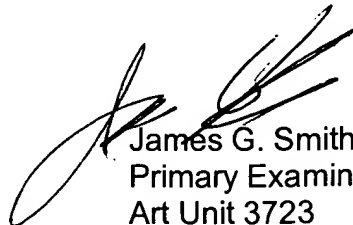
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A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to James G. Smith whose telephone number is 703-308-1746. The examiner can normally be reached on M-Th (7:05- 4:35) first Fri. off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph J. Hail, III can be reached on 703-308-2687. The fax phone numbers for the organization where this application or proceeding is assigned are 703-305-3579 for regular communications and 703-305-9835 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1148.



James G. Smith
Primary Examiner
Art Unit 3723

jgs
June 10, 2003